

Appl. No. 10/561,032 (based on PCT/US2004/021265)
Election and Amendment dated February 26, 2008
Reply to Office Action dated January 29, 2008

REMARKS:

Summarizing this paper, applicant has elected to have the prosecution of this application proceed with claims 1 – 9 and 14 – 17, the latter series having been added in the amendment. While claims 1 – 17 are here presented for consideration, applicant defers to the examiner as to whether or not claims 10 – 13, which were not elected, should be withdrawn from consideration.

With regard to the requirement for restriction, applicant transgresses that requirement. Here the traditional U.S. guidelines for restriction practice do not apply, because this application represents the national stage of a PCT application. Instead, one must look to see if a unity of invention exists insofar as independent claims 1 and 10 of this application are concerned. And unity of invention exists where there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special features. Technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art constitute “special technical features.” MPEP 1850 (I & II).

The examiner reasons that the only features claims 1 and 10 have in common are the “bearing structures,” and that they are obvious in view of JP 1006463 and the Tapered Roller Bearings website. Therefore, according to the examiner, the claims lack the same or corresponding special features. Applicant disagrees – and in effect, so did the European examiner to whom the corresponding PCT application was assigned. That examiner found that the claims possessed both novelty and an inventive step. Apart from that, the

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application underwent two preliminary examinations under Chapter II with the claims that now form the subject of the requirement for restriction, and in neither preliminary examination did the issue of unity of invention arise. Hence, the applicant transgresses the requirement for restriction.

The PCT application underwent a somewhat unusual prosecution – one that produced two International Preliminary Examination Reports. Applicant's assignee filed the PCT application designating the European Patent Office as the International Searching Authority. It produced a Written Opinion that found all of the original PCT claims lacking in an inventive step in view of JP 10096463 and a Tapered Roller Bearing website page showing a unitized single row tapered roller bearing. Applicant's assignee filed a request for a preliminary examination under Chapter II and with it submitted a new set of claims. Applicant's assignee intended to file the request with the European Patent Office, but inadvertently filed it in the U.S. Patent Office. Recognizing the mistake a few days later, applicant's assignee refiled the request with the European Patent Office and asked the U.S. Patent Office to ignore the earlier request inadvertently filed with it. The European examiner again considered the application in light of the new claims and the arguments that accompanied them and concluded that those claims set forth an invention that possessed both novelty and an inventive step. He issued an International Preliminary Examination Report confirming the same. The pertinent pages from that report are submitted herewith. Several months later the examiner to whom the U.S. national application is assigned issued

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another International Preliminary Examination Report, and it found the claims lacking in an inventive step in view of the very same references relied upon by the European examiner – but the U.S. examiner considered the original PCT claims, not the claims of the new set considered by the European examiner. Nor did the U.S. examiner appear to have the benefit of the arguments that accompanied the new set of claims.


The essence of the invention resides in substituting unitized single row tapered roller bearings for a variety of other bearings and bearing arrangements along the shafts that carry helical gearing in wind turbines. The issue as to whether or not this is unobvious arose in the PCT application and has indirectly arisen in this application in connection with a requirement for restriction. The substitution is not obvious, and the U.S. applicant - inventor has executed a declaration providing his observations on the issue. That declaration is submitted herewith.

Basically, despite all the attention given wind energy and wind turbines for extracting that energy, the experts in the field remain committed to the same old bearings and bearing arrangements and so do the manufacturers of wind turbine gear boxes. The single row unitized bearing in the website page are only available in small sizes and find use primarily in automotive wheel ends. Only applicant recognized their value for use with helical gearing in wind turbine gear boxes. This represents an unobvious advance, and the International Preliminary Examination Report recognized it as such.

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In view of the foregoing, allowance of the application with 17 claims – namely, claims
1 – 17 – is respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Edward A. Boeschenstein", written in black ink.

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